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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,046	10/01/2003	Courtney Konopka	81053 7114	6653

22242 7590 01/25/2007  
FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

EXAMINER
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CHANKONG, DOHM

ART UNIT	PAPER NUMBER
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2152

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.		Applicant(s)	
	10/678,046		KONOPKA ET AL.	
	Examiner		Art Unit	
	Dohm Chankong		2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 3-14, 16, 18, 19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-14, 16, 18, 19 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

- 1> This action is in response to Applicant's remarks, filed 11.7.2006. Claims 1, 3-14, 16, 18, 19 and 21 are presented for further examination.
- 2> This is a non-final rejection.

### *Response to Arguments*

- 3> Applicant's arguments with respect to the determination step in claim 1 has been considered and is persuasive. A new ground of rejection is introduced in this action to cure this deficiency.
- 4> Applicant's arguments with respect to claim 4 have been considered but are not persuasive. Wing discloses remotely receiving the diagnostic controller prior to identifying the device. Applicant's specification and claims (claim 5) disclose that "identifying" a electronic device can merely be "accessing the electronic device." The purpose of the identifying step is to determine appropriate scripts to be sent to the device [Applicant's specification, pg. 13 «lines 1-16»].

Similarly, Wing discloses sending a first script to the device that is solely responsible for "identifying" a device by testing for, among other things, the device's configuration [Figure 8 | 0085 | claim 20 : where a first script is sent, executed and at least a partial inventory of hardware is returned as a result of said execution]. Based on the results of the

Art Unit: 2152

identifying in this step, additional scripts are sent to the device [Figure 5 «items 512, 516» | 0081, 0085 | claim 20].

Under a second interpretation, Wing also discloses “identifying” a device through use of an identifier [0010, 0153]. A client application (diagnostic controller) is first downloaded to the client; the client application then “identifies” the device by transmitting the identifier of the device to the server in order to insure that the results of the diagnostics are properly coordinated to the device [0153-0155].

Thus, Wing discloses that the diagnostic controller (first script or client application) is received by the device prior to the identifying the device. The first script is responsible for identifying the device and returning results to the server to determine appropriate scripts to subsequently be sent back to the device. The client application is first downloaded to the client and subsequently transmits the device identifier to the server. Under either interpretation, Wing discloses the feature claimed in claim 4. The rejection of claim 4 set forth in the previous Office action are therefore maintained.

5> Applicant’s arguments with respect to claims 3 and 18 have been considered but are not persuasive. Applicant argues that there is no motivation to combine Balasubramaniam with Korn’s encryption capability. Applicant’s argument is based on Balasubramaniam’s disclosure of verifying a downloaded software object is from an authorized entity by insuring that the object is downloaded from an authorized URL.

Applicant’s argument is entirely without merit. Applicant’s argument seems to

Art Unit: 2152

suggest that since Balasubramaniam discloses a means of verifying a downloaded software object, there would be no need to encrypt the script as it is downloaded. However, these features are not mutually exclusive; a script can both be encrypted while it is downloaded while insuring that the script is being downloaded properly from the correct URL. Having one feature does not exclude the other.

Korn's encryption teachings supplement Balasubramaniam's system by improving the security with which scripts are downloaded. Korn argues one problem with prior art scripting systems is that they do not sufficiently protect against scripts that can do damage to the client [column 1 «lines 47-52»]. Balasubramaniam is one example of a deficient system because merely insuring that the script is downloaded from an authorized URL does not always guarantee the safety of the content of the script.

Korn's teaching of further encrypting the script enhances Balasubramaniam's system by providing another security mechanism that guarantees that the content of the script has not been tampered with by a hacker [column 2 «lines 39-51»]. Thus, there is motivation to combine the references to produce an script downloading system with enhanced security features. Based on the foregoing, Applicant's arguments with respect to claims 3 and 18 are not persuasive. The rejections of claims 3 and 18 set forth in the previous Office action are maintained.

6> Applicant's arguments with respect to claims 9-14 have been considered but are not persuasive. Applicant argues that Wing fails to teach that:

"a remote diagnostic controller...receives the web page and implement the at least one script...the remote diagnostic controller is further configured to receive a first reply from the

Art Unit: 2152

electronic device and to forward a second and/or subsequent instructions to the electronic device based on the first reply and/or previous replies.”

Applicant argues that Wing’s “entity which receives and executes the scripts is not the same as the entity which returns further instructions based on a first reply.”

Contrary to Applicant’s arguments, Wing discloses a diagnostic controller with each of the claimed limitations. Wing discloses that the diagnostic controller (Wing’s client application) is responsible for executing any script that is downloaded to the client device [0009-0012]. The diagnostic controller receives a first reply, the device’s identifier or inventory of the device’s components, from the electronic device [0009, 0010]. The diagnostic controller transmits the first reply to a server and receives additional instructions (scripts), sent from the server based on the first reply, to be executed by the controller. The controller “forwards” the instructions to the client device by executing the instructions at the client device (as the controller is installed at the device).

Thus, Applicant’s arguments with respect to 9-14 are not persuasive. Wing discloses the limitations of claim 12 as claimed. The rejections set forth in the previous office action with respect to claims 9-14 are therefore maintained.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7> The rejection of claims not formally addressed in this action can be found in a prior Office action.

8> Claims 1, 4-8, 16, 19 and 21 are rejected under 35 U.S.C § 103(a) as being unpatentable over Balasubramaniam et al, U.S Patent No. 6.701.441 ["Balasubramaniam"], in view of Wing et al, U.S Patent Publication No. 2004/0236843 ["Wing"], in further view of Johnson et al, U.S Patent No. 6.397.245 ["Johnson"].

9> Johnson was cited by the Office in PTO-892, filed 9.14.2005.

10> As to claim 1, Balasubramaniam discloses a method for use in remotely diagnosing an electronic device, comprising:

initiating a diagnostic analysis of an electronic device [column 11 «lines 32-48»];

identifying the electronic device [column 7 «lines 42-57» | column 10 «lines 32-60 where : "registering" the user computer];

receiving a plurality of scripts for diagnosing the electronic device communicated over a distributed network, wherein the receiving the plurality of scripts includes receiving within the diagnostic controller at least one web page having the plurality of scripts and the diagnostic controller extracting at least one of the plurality of scripts from the web page [column 5 «lines 23-35» | column 9 «lines 36-54» where : the ActiveX control corresponds to a diagnostic controller];

remotely initiating a first diagnostic instruction with at least one of the plurality of scripts [column 11 «lines 52-59» | column 12 «lines 29-32»];

determining a second diagnostic instruction based on the response with at least one of the plurality of scripts [column 11 «lines 46-48 and 60-65»]; and

remotely initiating the second diagnostic instruction with at least one of the plurality of scripts [column 11 «lines 60-65»].

Balasubramaniam does not expressly disclose receiving a response based on the first diagnostic instruction. However, Balasubramaniam does disclose that “the server computer 100 checks if any other programs (scripts, diagnostic instruction) need to be downloaded...” [column 11 «lines 61-62»]. According to Wing, one method to check whether additional scripts are necessary is to look at the received responses from previous diagnostic instructions [0108-0111]. The benefit of such a feature is to allow for results-based testing to determine whether additional diagnostic instruction is necessary to diagnose or maintain the device. Thus, it would have been obvious to combine Balasubramaniam’s remote diagnostic system with this feature as taught by Wing.

Balasubramaniam also does not expressly disclose determining whether the electronic device comprises a diagnostic controller before transmitting the controller. However, such a step is obvious to one of ordinary skill in the art and does not at all provide any patentable distinction between Applicant’s invention and the prior art references. In addition, Johnson specifically discloses the functionality of first determining whether a control already is present at a client device [Figure 6B : “check installation step” | column 11 «lines 2-16» where : Johnson discloses checking whether the control has already been installed on the client



computer]. It would have been obvious to one of ordinary skill in the art to have incorporated this determination feature into Balasubramaniam as such a step is well known and ubiquitous in the art. The determination step, as taught by Johnson, prevents unnecessary downloads of controls if a control is already present on the client device.

11> As to claim 4, Wing discloses remotely receiving the diagnostic controller over the distributed network prior to the identifying the electronic device [Figures 5, 8 | 0081-0085 | 0153]. It would have been obvious to one of ordinary skill in the art to incorporate Wing's teachings into Balasubramaniam's invention. One would have been motivated to provide such a combination as Wing's teachings would improve Balasubramaniam's ability to select appropriate diagnostic scripts based on an identification of the device.

12> Claim 3 and 18 are rejected under 35 U.S.C § 103(a) as being unpatentable over Balasubramaniam and Wing, in further view of Korn, U.S Patent No. 6.880.083.

13> Claims 9-14 are rejected under 35 U.S.C § 103(a) as being unpatentable over Balasubramaniam and Wing, in further view of Sewell et al, U.S Patent Publication No. 2002|0165952 ["Sewell"].

### *Conclusion*

Art Unit: 2152

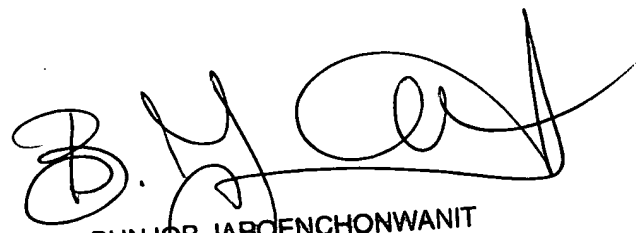
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942.

The examiner can normally be reached on Tuesday-Friday [7:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC



BUNJOB JAROENCHONWANIT  
SUPERVISORY PATENT EXAMINER